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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/16/2003

Ranjan Mukherjee

D0295 NP

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7590

05/30/2006

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PATENT DEPARTMENT

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EXAMINER

DUNSTON, JENNIFER ANN

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Claims 1-16 are pending in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a method of identifying a peroxisome proliferator activated receptor modulator, comprising measuring the level of an mRNA transcript of a PPAR responsive gene, classified in class 435, subclass 6.
- II. Claims 6-10, drawn to a method of identifying a peroxisome proliferator activated receptor modulator, comprising measuring the level of protein expression of a PPAR responsive gene, classified in class 435, subclass 7.1.
- III. Claims 11-16, drawn to a method of identifying a peroxisome proliferator activated receptor modulator, comprising measuring the functional activity of a protein encoded by a PPAR responsive gene, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-III are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups I-III comprise steps which are not required for or present in the methods of the other groups: measuring the level of an mRNA transcript of a PPAR responsive gene (Group I), measuring the level of protein expression of a PPAR responsive gene (Group II), and measuring the functional activity of a protein encoded by a PPAR responsive gene (Group III). The end results of the

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methods are different in that each method will result in the identification of a compound that is able to modulate gene expression, protein expression, or protein activity, respectively. Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Further, the search for each method requires a separate search of the patent and non-patent literature to search the method step(s) not shared with any other group. Therefore, the searches are not coextensive, and the additional searching that is required to search more than one group would impose a serious search burden.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

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either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR, <http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business

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Center will notify applicants of the resolution of the problem within 5-7 business days.

Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jennifer Dunston, Ph.D.
Examiner
Art Unit 1636

jad

CECILE QIAN, PH.D.
PRIMARY EXAMINER

